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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,720	05/20/2004	Jeffery A. Westendorp	HSIND 1.1	2103
7590	06/02/2005		EXAMINER	
Jeffery A. Westendorp Walters Gardens, Inc. 1992 - 96th Ave. P.O. Box 137 Zeeland, MI 49464-0137			KRAWCZEWCZ MYERS, LOUANNE C	
			ART UNIT	PAPER NUMBER
			1661	
DATE MAILED: 06/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/849,720	WESTENDORP, JEFFERY A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Louanne C. Krawczewicz Myers	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 May 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 20 May 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### Objection to the Disclosure

#### 37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

### **35 USC 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

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In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112 first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

- A. Applicant is requested to import into the specification a brief comparison between the instant plant and the parental cultivar(s), 'Revolution', such need not be in any great detail, but should at least be to the extent necessary to positively distinguish the respective plants from each other.
- B. Applicant is requested to import into the specification a brief comparison between the instant plant and the closest known cultivar, such need not be in any great detail, but should at least be to the extent necessary to positively distinguish the respective plants from each other.
- C. Applicant states the instant plant was discovered as an "un-induced sport of the Hosta cultivar 'Revolution' ". However, Applicant has not stated whether

the instant plant was a whole plant or branch sport. The origin of the plant should be unambiguously set forth in the specification.

- D. Page 1, lines 9-11, if the instant plant is stable and reproduces true to type, then Applicant should also state in the specification --The new variety is stable and reproduces true to type in successive generations of asexual reproduction.--.
- E. Page 1, line 14, Rather than stating "invention", it appears --plant-- would be the more appropriate term to use in this instance.
- F. Page 3, line 14, Applicant sets forth in the specification the instant plant's height. However, even though Applicant states "at flowering", it is unclear if this height is the height from the soil level to the top of the leaf plane or if this is the height from the soil level to the top of the flowering stems. Applicant should set forth in the specification the instant plant's typical and mature plant height from the soil level to the top of the leaf plane and from the soil level to the top of the flowering stems.

G. Page 3, lines 15-19, Applicant should set forth in the specification additional information relative to the instant plant's leaves including the typical and observed leaf texture, venation pattern and vein color (both surfaces) with reference to the employed color chart, if readily available.

H. Page 3, lines 20-21 and page 4, lines 1 and 2, Applicant states "Center adaxial surface of young emerging leaves is a deep green closest to RHS 141 A on the margin." It is unclear whether Applicant is referring to the instant plant's adaxial surface center or margin. Further, Applicant states "Later in the growing season, the margin is between RHS 139 A and 136 A. The adaxial margin surface is RHS 11 B to RHS 11 C on young leaves, and whiter than RHS 155 D on leaves later in the season." These recitations are contradictory. Also, the instant plant's margin on the upper surface does not appear to have the RHS 139 A and 136 A colorations when compared to the drawings provided. Correction to the specification and/or clarification is necessary.

- I. Page 3, lines 20-21 and page 4, lines 1- 2, Applicant sets forth colorations for the upper surface of the leaves. However, when compared to the drawings provided, it appears there are additional colorations present. Applicant has set forth intermediate colorations for the abaxial surface at lines 2-8 of page 4. However, it is uncertain whether these colorations are set forth for the

abaxial surface or for the adaxial and abaxial surfaces. Correction to the specification and/or clarification is necessary. Applicant should set forth in the specification all colorations present on both surfaces with reference to the employed color chart.

- J. Page 4, lines 4-8, Applicant states the prominent color bands are N138C and 143B. Applicant then states the main intermediate band is 144C on young leaves with little change over the season. It is uncertain whether the prominent color band and main intermediate band are one and the same or different. Correction to the specification and/or clarification is necessary.
- K. Page 4, lines 7 and 8, Applicant states "The green flecks in the margin are variable and range from RHS 136 A to RHS 138 A with the same color in the abaxial side." It does not appear that the colorations of the green flecks on the adaxial side have been set forth. It is unclear what colorations are being compared. Correction to the specification and/or clarification is necessary.
- L. Page 4, line 13, Applicant should set forth in the specification additional information relative to the instant plant's buds including the typical and observed shape.

M. Page 4, lines 14-16, Applicant should set forth in the specification additional information relative to the instant plant's flowers including number of flowering stems or scapes per plant.

N. Page 4, lines 17-19, Applicant should set forth in the specification additional information relative to the instant plant's bracts including the typical and observed shape, and apex, base, and margin descriptors.

O. Page 4, line 15, Applicant states "persists for a normal period, up to two days". Applicant should set forth in the specification additional information relative to the instant plant's flowers including flower longevity on and off the plant.

P. Page 5, lines 2-4, Applicant should set forth in the specification additional information relative to the instant plant's tepals including the typical and observed tepal shape, margin descriptor, and coloration (both surfaces) with reference to the employed color chart. It is noted that Applicant has not stated whether the colorations set forth are for the upper, lower, or both

surfaces. Applicant should account for all colorations present on both surfaces with reference to the employed color chart.

Q. Applicant should set forth in the specification the number of pistils per flower.

R. Page 5, line 6, Applicant states "to 3 mm". It appears that Applicant has left out a measurement before "to". Correction to the specification and/or clarification is necessary.

S. Applicant should set forth in the specification information relative to the instant plant's Pest resistance/susceptibility.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

**Claim Rejection**

**35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> Paragraphs**

**Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.**

**Comments**

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance.

Applicant should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

Applicant should note the new amendment format. (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louanne C. Krawczewicz Myers whose telephone number is (571) 272-0979. The examiner can normally be reached on Monday and Thursday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone numbers for the group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent electronic business center whose telephone number is (866)-217-9197 (toll free) or (703) 305-3028 or (703) 308-6845 or email requests to [ebc@uspto.gov](mailto:ebc@uspto.gov).

LKM

*LKM*

KENT BELL  
PRIMARY EXAMINER

*Kent Bell*